



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
930,194	08/02/78	Ulrich Stache, et al	266073

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EXAMINER	
Roberts	
ART UNIT	PAPER NUMBER
125	6

DATE MAILED:

MAILED

OCT 30 1979

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on Sept. 13, 1979 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited, Form PTO-892. 2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152. 4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 6-25 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 6-25 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been: ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

The claims now in the case are 6-25.

Claims 6-19 are rejected under 35 USC 103 as being obvious from Stache et al in combination with Ercoli et al, both of record and Sarett, newly cited. The primary reference discloses 17~~α~~,21-ortho carbonate derivatives of various ^{1,4} pregnadiene compounds. See col. 2 lines 50-60 and examples 1-14. Ercoli discloses a process for the preparation of 17 mono and 17,21diesters by subjecting their 17 ,21 ortho precursor to a weak acid hydrolysis; and if desired subjecting the 21-hydroxy group of the 17 -acyloxy 21-hydroxy compound to acylation to obtain a mixed 17,21-diester. Hence, application of the process shown in the secondary reference to the ortho compounds shown by Stache et al to obtain the claimed compounds would be obvious to one of ordinary skill in the steroid art. The Sarett references is cited to show the conventionality of the various 17 - carbonates species. With respect to claims 18 and 19, it is the examiner's position that one of ordinary skill in the art, upon contemplating the nature of the claims, in view of his knowledge that closely related steroid compounds have been combined with pharmaceutically acceptable carriers in a manner similar to that here and administered to treat inflammatory conditions, would find adequate suggestion of the subject matter as a whole which is claimed. The totality of the teachings of the cited references makes the claimed subject matter obvious to one of ordinary skill in the art.


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Claims 20-25 are rejected under 35 USC 103 as being obvious from the disclosure of Ercoli et al. The reference has been explained supra. Attention is respectively directed to col. 3 lines 50-63 and col. 4 lines 1-65. The mere fact that applicants starting materials differ from that shown by the prior art is of no consequence since an old process does not become patentable anew when applied to closely analogous compounds to obtain expected results.

This application should be prepared for final action.


Albert L. Roberts
Primary Examiner
Art Unit 125

Roberts/tmw

A/C 703

557-2575

10/23/79